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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,463	03/18/2004	Franck Rotion	11349-20	5549
20583	7590	12/01/2004	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017				HAWKINS, CHERYL N
		ART UNIT		PAPER NUMBER
		1734		

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/803,463	ROLION, FRANCK
	<b>Examiner</b>	<b>Art Unit</b>
	Cheryl N Hawkins	1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9, 17, 18, 21 and 22 is/are rejected.
- 7) Claim(s) 10-16, 19 and 20 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/18/04; 7/28/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Stevens (US 5,714,035). Stevens discloses a hand-held device for transferring a film onto a substrate, the hand-held device comprising a housing (Figure 1, casing 1) configured for accommodating a film supply (Figure 2, supply and take-up spools 2 and 3); and an application member projecting from the housing along a longitudinal axis; wherein the application member has at least two application member portions (Figure 2, members 9 and 10) movable relative to each other; and motion stops (Figures 5b and 5c, stop faces 21 and 22) corresponding with each other are arranged at the movable application member portions, the stops bordering the relative movement between the movable application member portions.

As to Claim 2, Stevens discloses a hand-held device wherein the motion stops (Figures 5b and 5c, stop faces 21 and 22) include at least one pair of stops provided at an axial distance from each other.

As to Claim 3, Stevens discloses a hand-held device wherein the motion stops include at least one pair of stops (Figures 5b and 5b, stop faces 21 and 22) directed towards the peripheral direction and at a distance from each other perpendicular to the longitudinal axis.

As to Claim 4, Stevens discloses a hand-held device wherein the application member (Figure 2, members 9 and 10) has an upper side, a bottom side, and side surfaces; and at least one pair of stops (Figures 5b and 5c, stop faces 21 and 22) is provided at side surfaces of the application member.

As to Claim 5, Stevens discloses a hand-held device wherein a cross-sectional reduction is provided between the movable application member portions (Figures 5a-5c, tip supporting member 9, tip 10).

As to Claim 6, Stevens discloses a hand-held device wherein the cross-sectional reduction is constituted by a gap (Figure 1, slot 18).

As to Claim 9, Stevens discloses a hand-held device wherein the application member has a remaining cross-section at a coaxial position relative to the cross-sectional reduction (Figures 5a-5c, tip supporting member 9, tip 10).

3. Claims 1-4, 17, 18, 21, and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by Katsuaki (JP 2001-089011). Katsuaki discloses a hand-held device for transferring a film onto a substrate, the hand-held device comprising a housing (Figure 1, case portions 3a and 3b) configured for accommodating a film supply; and an application member (Figure 4, application member A) projecting from the housing along a longitudinal axis; wherein the application member has at least two application member portions (Figure 2, applicator portions 8 and 9) movable relative to each other; and motion stops (Figure 2, guiding portions 12) corresponding with each other are arranged at the movable application member portions, the stops bordering the relative movement between the movable application member portions.

As to Claim 2, Katsuaki discloses a hand-held device wherein the motion stops (Figure 2, guiding portions 12) include at least one pair of stops provided at an axial distance from each other.

As to Claim 3, Katsuaki discloses a hand-held device wherein the motion stops (Figure 2, guiding portions 12) include at least one pair of stops provided directed towards the peripheral direction and at a distance from each other perpendicular to the longitudinal axis.

As to Claim 4, Katsuaki discloses a hand-held device wherein the application member (Figure 2, application member A) has an upper side, a bottom side, and side surfaces; and at least one pair of stops (Figure 2, guiding portions 12) is provided at the side surfaces of the application member.

As to Claim 17, Katsuaki disclose a hand-held device wherein the movable application member portions (Figure 4, applicator portions 8 and 9) are formed by flat gibs placed one behind the other.

As to Claim 18, Katsuaki discloses a hand-held device which further comprises lateral webs (Figures 4 and 5, guiding portions 12) protruding upwards and downwards from both sides of the flat gibs (Figure 4, applicator portions 8 and 9).

As to Claim 21, Katsuaki discloses a hand-held device wherein the stops (Figure 2, guiding portions 12) are formed by the upper borders of the lateral webs.

As to Claim 22, Katsuaki discloses a hand-held device wherein the application member (Figure 4, applicator member A) is formed by an application gib; and the movable application member portions (Figure 4, applicator portions 8 and 9) are resiliently bendable and torsional relative to each other.

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4. Claims 1, 2, 4-6, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Czech (US 5,303,759). Czech discloses a hand-held device for transferring a film onto a substrate, the hand-held device comprising a housing (Figure 1, housing 7) configured for accommodating a film supply; and an application member (Figure 1, applicator device 2) projecting from the housing along a longitudinal axis; wherein the application member has at least two application member portions (Figures 2 and 3, mounting body 5, applicator body 6) movable relative to each other; and motion stops (Figures 3 and 6, bottom corner surfaces of mounting body 5) corresponding with each other are arranged at the movable application member portions, the stops bordering the relative movement between the movable application member portions.

As to Claim 2, Czech discloses a hand-held device wherein the motion stops (Figures 3 and 6, bottom corner surfaces of mounting body 5) include at least one pair of stops provided at an axial distance from each other.

As to Claim 4, Czech discloses a hand-held device wherein the application member (Figure 1, applicator device 2) has an upper side, a bottom side, and side surfaces; and at least one pair of stops is provided at upper side of the application member.

As to Claim 5, Czech discloses a hand-held device wherein a cross-sectional reduction (Figure 6, ball head 8 and projection 14) is provided between the movable application member portions (Figure 6, mounting body 5, applicator body 6).

As to Claim 6, Czech discloses a hand-held device wherein the cross-sectional reduction is constituted by a gap (Figure 6, space between ball head 8 and projection 14).

As to Claim 9, Czech discloses a hand-held device wherein the application member has a remaining cross-section at a coaxial position relative to the cross-sectional reduction (Figure 6, ball head 8, projection 14).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens (US 5,714,035). Stevens discloses a hand-held device for transferring a film onto a substrate, the hand-held device comprising a housing (Figure 1, casing 1) configured for accommodating a film supply (Figure 2, supply and take-up spools 2 and 3); and an application member projecting from the housing along a longitudinal axis; wherein the application member has at least two application member portions (Figure 2, members 9 and 10) movable relative to each other; and motion stops (Figures 5b and 5c, stop faces 21 and 22) corresponding with each other are arranged at the movable application member portions, the stops bordering the relative movement between the movable application member portions.

As to Claim 2, Stevens discloses a hand-held device wherein the motion stops (Figures 5b and 5c, stop faces 21 and 22) include at least one pair of stops provided at an axial distance from each other.

As to Claim 3, Stevens discloses a hand-held device wherein the motion stops include at least one pair of stops (Figures 5b and 5b, stop faces 21 and 22) directed towards the peripheral direction and at a distance from each other perpendicular to the longitudinal axis.

As to Claim 4, Stevens discloses a hand-held device wherein the application member (Figure 2, members 9 and 10) has an upper side, a bottom side, and side surfaces; and at least one pair of stops (Figures 5b and 5c, stop faces 21 and 22) is provided at side surfaces of the application member.

As to Claim 5, Stevens discloses a hand-held device wherein a cross-sectional reduction is provided between the movable application member portions (Figures 5a-5c, tip supporting member 9, tip 10).

As to Claim 6, Stevens discloses a hand-held device wherein the cross-sectional reduction is constituted by a gap (Figure 1, slot 18).

As to Claims 7 and 8, Stevens discloses a hand-held device wherein the gap has a small axial width (Figure 1, slot 18) to provide a complementary bearing surface for the two movable application member portions, but does not disclose the gap as having an axial width less than 1mm. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the apparatus of Stevens with a gap having a small axial width, i.e. 1 millimeter, to provide a complementary bearing surface for the two movable application member portions.

As to Claim 9, Stevens discloses a hand-held device wherein the application member has a remaining cross-section at a coaxial position relative to the cross-sectional reduction (Figures 5a-5c, tip supporting member 9, tip 10).

7. Claims 1, 2, and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Czech (US 5,303,759). Czech discloses a hand-held device for transferring a film onto a substrate, the hand-held device comprising a housing (Figure 1, housing 7) configured for accommodating a film supply; and an application member (Figure 1, applicator device 2)

projecting from the housing along a longitudinal axis; wherein the application member has at least two application member portions (Figures 2 and 3, mounting body 5, applicator body 6) movable relative to each other; and motion stops (Figures 3 and 6, bottom corner surfaces of mounting body 5) corresponding with each other are arranged at the movable application member portions, the stops bordering the relative movement between the movable application member portions.

As to Claim 2, Czech discloses a hand-held device wherein the motion stops (Figures 3 and 6, bottom corner surfaces of mounting body 5) include at least one pair of stops provided at an axial distance from each other.

As to Claim 4, Czech discloses a hand-held device wherein the application member (Figure 1, applicator device 2) has an upper side, a bottom side, and side surfaces; and at least one pair of stops is provided at upper side of the application member.

As to Claim 5, Czech discloses a hand-held device wherein a cross-sectional reduction (Figure 6, ball head 8 and projection 14) is provided between the movable application member portions (Figure 6, mounting body 5, applicator body 6).

As to Claim 6, Czech discloses a hand-held device wherein the cross-sectional reduction is constituted by a gap (Figure 6, space between ball head 8 and projection 14).

As to Claims 7 and 8, Czech discloses a hand-held device wherein the gap has a small axial width (Figure 6, space between the ball head and projection 14) between the two members comprising the cross-sectional reduction, but does not disclose the gap as having an axial width less than 1mm. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the apparatus of Czech with a gap having a small axial width, i.e. 1 millimeter, to separate the two members comprising the cross-sectional reduction.

As to Claim 9, Czech discloses a hand-held device wherein the application member has a remaining cross-section at a coaxial position relative to the cross-sectional reduction (Figure 6, ball head 8, projection 14).

***Allowable Subject Matter***

8. Claims 10-16, 19, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

As to Claim 10, the prior art of record does not disclose or suggest any motivation for modifying the movable application member portions of Stevens or Czech to be formed by flat gibs placed one behind the other.

As to Claim 19, the prior art of record does not disclose or suggest any motivation for modifying the lateral webs of Stevens or Katsuaki to include a cross-sectional reduction which is provided in the lateral webs.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl N Hawkins whose telephone number is (571) 272-1229. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A Fiorilla can be reached on (517) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheryl N. Hawkins  
November 24, 2004

*ca*  
**CHRIS FIORILLA**  
**SUPERVISORY PATENT EXAMINER**  
*Au 1734*